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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,567	08/28/2003	Grigorii Lev Soloveichik	134860-1	8242
23405	7590	06/27/2005	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203				SHIPPEN, MICHAEL L
ART UNIT		PAPER NUMBER		
		1621		

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/650,567	SOLOVEICHIK, GRIGORII LEV	
	Examiner	Art Unit	
	MICHAEL L. SHIPPEN	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 11-23 and 25-27 is/are rejected.
- 7) Claim(s) 7-10 and 24 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/28/03; 2/22/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |



DETAILED ACTION***Claim Rejections - 35 USC § 112¹***

Claims 11 and 12 are rejected under 25 USC 112, second paragraph, as failing to particularly point out the claimed invention. The use of the term "anhydrous" is ambiguous since claim 12 indicates that water is intended to be present. If water is present, it cannot be anhydrous in the normal meaning of the term. As such, the actual scope of the term cannot be determined.

Claims 20 and 21 are rejected under 25 USC 112, second paragraph, as failing to particularly point out the claimed invention. The use of the expression "organic solvent" is ambiguous since claim 21 indicates that it may be water. The normal meaning of "organic solvent" would not embrace water, which is not organic. As such, the actual scope of the expression cannot be determined.

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102²

Claims 1, 2, 4-6, 11-20, 23, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Neumann (J. Chem. Soc., Chem. Commun, pp. 1285-7 (1988)). The reference teaches the contacting a hydroxyaromatic compound (phenol, cresol, etc.) with oxygen (air) and a bromine compound selected from the group consisting of hydrogen bromide, in an acidic medium (HBr), in the presence of a catalyst selected from the group of compounds and mixtures of compounds of Group IV-VIII transition metals of the Periodic Table of Elements ($H_5PMo_{10}V_2O_{40}$) which anticipates all of the claimed limitations, note the examples represented in Tables 1 and 2 of the reference.

Claim Rejections - 35 USC § 103³

Claims 1, 2, 4-6, 11-21, 23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neumann (J. Chem. Soc., Chem. Commun, pp. 1285-7 (1988)). The reference is applied as above. Besides the examples of the reference, one would expect to be able to vary the reaction conditions set forth and still obtain

² The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

³ The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

similar results. Moreover, the optimization of reaction conditions for a particular reaction system to optimize a result (such as to maximize the yield of a desired product) is well within the skill of the artisan through routine experimentation, *In re Aller*, 105 USPQ 233. Furthermore, to the extent the instant claims read on reactants not exemplified in the examples of the reference, such reactants are considered obvious. The claimed reactants are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious.

Double Patenting⁴

Claims 1-6, 11, 13-23, 25 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 12-23 of copending Application No. 10/650,566. Although the conflicting

⁴ The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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claims are not identical, they are not patentably distinct from each other because the claims clearly overlap. The instant claims differ from the conflicting claims in that the instant claims recite "an acidic medium". However, the conflicting claims are intended to read on processes wherein acidic solvents, such as acetic acid, are used, note the examples and claims 17 and 18 of the conflicting application. The use of such solvents would result in "an acidic medium" anticipating the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

Applicants should update the status of copending applications cited in the specification. Each application should also be identified by its serial number. It is particularly noted that none of the recited application actually having an issue date since they are still pending. Correction is required.

Allowable Subject Matter

Claims 7-10 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

The references are cited as of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **571-273-8300**.

MShippen
June 23, 2005



**MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621**